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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,578	12/14/2001	Stephen M. Brinkman	B-0114.07	6140

7590 02/11/2004

LAW OFFICES OF CHRISTOPHER L. MAKAY
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 San Antonio, TX 78205

EXAMINER

HAYES, BRET C

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/017,578

Applicant(s)

BRINKMAN, STEPHEN M.

Examiner

Bret C Hayes

Art Unit

3644

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 30-32 and 39-41.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Charles T. Jordan
CHARLES T. JORDAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

EXPLANATION OF HOW THE AMENDED CLAIMS WOULD BE REJECTED

1. This is to explain how the amended claims would be rejected as set forth at PTOL-303, item #7.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 30, 31 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin ('964).
4. Re – claims 30 and 31, '964 discloses the claimed invention except for a sleeve coupled with the tail to provide an aperture at the tail, wherein the fishing line passes through the sleeve thereby securing the fishing line at the tail. (*Amended portion of claim underlined.*) In the previous rejection, Paper No. 13, the addition of a sleeve to the lure was obviated by the aperture 9 of '964, since it is well known in the analogous art of guiding shafts through apertures to use sleeves, i.e., wear items such as bushings, for the purpose of limiting the wear on the aperture itself. The Applicant makes no argument against this rejection in the response filed 5 February 2004, but instead argues that the claim, as amended, overcomes the prior art. However, it would have also been obvious to one having ordinary skill in the art at the time the invention was made to substitute a sleeve for the aperture disclosed by '964, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. In this case, to remove the aperture and replace it with a sleeve functioning in the same capacity as the aperture would be obvious to one having ordinary skill in the art at the time the invention was made.

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5. Re – claim 39, see previous office action, Paper No. 13, paragraph 8.
6. Re – claim 32, see previous office action, Paper No. 13, paragraphs 9 – 12.
7. Concerning method claims 40 and 41, in view of the structure disclosed by '964, as applied to claims 30, 31 and 39 above, the method of operating the device would have been inherent, since it is the normal and logical manner in which the device could be used.
8. Further, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). In this case, as set forth above at paragraph 2, the sleeve functions as the aperture and so cannot affect the method in a manipulative sense.

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306 – 0553. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan, can be reached at (703) 306 – 4159. The fax number is (703) 872 – 9306.

bh

2/6/04

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